REMARKS

I. Status and Disposition of the Claims

In the instant Application, claims 1-49 are pending. Of these pending claims, claims 1, 23, and 45 are independent.

In the Office Action[1] mailed February 2, 2009, the following actions were taken:

- Claims 1-10, 23-32, and 45-49 were rejected under 35 U.S.C. §103(a) as being unpatentable over Lonnroth et al. (U.S. Patent No. 6,826,597 B1) (hereinafter *"Lonnroth"*) in view of Dutta (U.S. Patent No. 6,615,212 B1) (hereinafter *"Dutta"*);

- Claims 11-13, 15-22, 33-35, and 37-44 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Lonnroth* and *Dutta* as applied to claims 1 and 23 in view of Bauer et al. (U.S. Patent No. 5,884,325) (hereinafter "*Bauer*"); and

- Claims 14 and 36 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Lonnroth* and *Dutta* as applied to claims 1 and 23 in view of Koskimies (U.S. Publication No. 2003/0233383) (hereinafter *"Koskimies"*).

Applicant respectfully traverses the rejections and request reconsideration based on the following remarks.

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[1] The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

In addition, Applicant does not necessarily agree with or acquiesce to the Examiner's characterization of the claims or the prior art, even if those characterizations are not addressed herein.

II.   Response to Rejections

In this Response to the Office Action, Applicant respectfully traverses the rejections listed above.

A.   The Rejection of the Claims under 35 U.S.C. §103(a) should be withdrawn.

Applicant respectfully traverses the above identified rejection of claims because a *prima facie* case of obviousness has not been established. "The key to supporting any rejection under 35 U.S.C. §103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements." M.P.E.P. §2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). "In determining the differences between the prior art and the claims, the question under 35 U.S.C. §103 is not whether the differences <u>themselves</u> would have been obvious, but whether the claimed invention <u>as a whole</u> would have been obvious. M.P.E.P. §2141.02(I) (emphases in original).

"[T]he framework for objective analysis for determining obviousness under 35 U.S.C. §103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the

prior art." M.P.E.P. §2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. §2141(III).

The Supreme Court in *KSR Int'l Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385 (U.S. 2007) held that "[t]here is no necessary inconsistency between the idea underlying the TSM [teaching, suggestion, motivation] test and the *Graham* analysis." M.P.E.P. §2141 (rev. 6, Sept. 2007), citing *KSR* at 82 U.S.P.Q. 2d at 1396. Applicant understands this to mean that when applicable, as here, TSM reasoning may still be applied not only by an examiner but also by Applicant to refute a §103 rejection.

Here, a *prima facie* case of obviousness has not been established because the scope and content of the prior art has not been properly determined, nor have the differences between the claimed invention and the prior art been properly ascertained. Accordingly, a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art has not been clearly articulated.

i. Claims 1-10, 23-32, and 45-49

The Examiner rejected claims 1-10, 23-32, and 45-49 under 35 U.S.C. §103(a) as being anticipated by *Lonnroth* in view of *Dutta*. See Office Action at 2. Applicant respectfully disagrees with and traverses this rejection.

In rejecting claims 1 and 23 under 35 U.S.C. §103(a) as being unpatentable over *Lonnroth* in view of *Dutta*, the Office Action asserted, on page 3, "It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of [Lonnroth] with the teachings of Dutta in order to be able to

improve the method of transcoding data formats and sending information to minimize transmission times."

Applicant respectfully disagrees because the references, alone and in combination, fail to teach or suggest each and every element of the claims. In addition, no additional evidence has been raised establishing a tenable rationale why one of ordinary skill would have been motivated to modify the references so as to arrive at the claimed invention. In particular, neither *Lonnroth* nor *Dutta* teaches or suggests: "transmitting a change of the data format from the client to the server in a data object definition message," and "automatically adapting the translation code to the changed data format upon receipt of the data object definition message," as recited in claim 1.

The Office Action confirms that *Lonnroth* does not clearly disclose "transmitting a change of the data format from the client to the server in a data object definition message." See Office Action at 3. *Dutta* does not cure this deficiency, as it does not teach the above cited element.

The Office Action cites to col. 7, lines 63-67, col. 8, lines 1-22, col. 9, lines 13-67 and col. 10, lines 1-7 of *Dutta* as disclosing "transmitting a change of the data format from the client to the server in a data object definition message." See Office Action at 3. This is incorrect. In these sections, *Dutta* discloses flowcharts illustrating preferred methods of operation of the transcoding proxy server and operation of the client. See, e.g., *Dutta* at col. 8, lines 23-25; col. 9, lines 28-30. Specifically, *Dutta* teaches, "If the content received is not in the requested format, then the client determines whether a content analyzer for the received format is available (either because the client currently has one or because a content analyzer has been received along with the request

content.... If the client does not have a content analyzer... the client may simply wait for the requested format...." See *Dutta* at col. 9, lines 38-50. Therefore, the client in *Dutta* does not transmit a change of the data format to the server let alone have a change of the requested data format. Nowhere in the cited sections or elsewhere in *Dutta* is there a suggestion or teaching of automatically configuring a translation code comprising, "transmitting a change of the data format from the client to the server in a data object definition message," as recited in claim 1.

Moreover, neither *Lonnroth* nor *Dutta* teaches or suggests, "automatically adapting the translation code to the changed data format upon receipt of the data object definition message," as recited in claim 1. The Examiner refers to *Lonnroth* col. 4, lines 6-24 and *Dutta* col. 7, lines 63-67, col. 8, lines 1-22, col. 9, lines 13-67 and col. 10, lines 1-7 as allegedly disclosing "automatically adapting the translation code to the changed data format upon receipt of the data object definition message." See Office Action at 2. Since *Lonnroth* and *Dutta* first fail to even disclose transmitting changed data formats, they do not teach or suggest the use of such changed data formats by <u>automatically adapting</u> the translation code <u>to the changed data format upon receipt</u> of the data object definition message as recited in claim 1. There are further no independent data model messages in *Lonnroth* nor *Dutta*. *Lonnroth* or *Dutta* does not suggest a mechanism for adapting to changes within a data object definition message. *Lonnroth* and *Dutta* simply fail to teach or suggest automated adaptation of a translation code upon receipt of such changes in an object definition message.

For at least these reasons, a prima facie case of obviousness with respect to claim 1 has not been established and, therefore, the rejection of claim 1 under 35

U.S.C. §103 as being obvious from *Lonnroth* in view of *Dutta* is improper and should be withdrawn. For at least the reasons stated above with respect to claim 1, the rejection of claims 2-10, which depend directly or indirectly from claim 1 and therefore include all the limitations thereof, is also improper and should be withdrawn. In addition, for claims 2-10, no statement or adequate rationale as to why the references are combinable is provided.

Although of different scope, independent claims 23 and 45 recite similar features and thus also are allowable for at least the same reasons as claim 1. For at least the reasons stated above with respect to claims 23 and 45, the rejection of claims 24-32 and 46-49, which depend directly or indirectly from claims 23 and 45, respectively, is also improper and should be withdrawn.

ii. Claims 11-13, 15-22, 33-35, and 37-44

Claims 11-13, 15-22, 33-35, and 37-44 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Lonnroth* and *Dutta* as applied to claims 1 and 23, in view of *Bauer*. See Office Action at 7. Applicant respectfully traverses the rejection.

Claims 11-13, 15-22, 33-35, and 37-44 depend directly or indirectly from claims 1 and 23, and include all the limitations thereof. As set forth above with respect to claims 1 and 23, the combination of *Lonnroth* and *Dutta* fails to teach, disclose or suggest the features recited in claims 1 and 23, and required by claims 11-13, 15-22, 33-35, and 37-44, namely, that "transmitting a change of the data format from the client to the server in a data object definition message," and "automatically adapting the translation code to the changed data format upon receipt of the data object definition message." *Bauer*

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fails to cure the deficiencies of *Lonnroth* and *Dutta* discussed above. That is, *Bauer* also fails to teach, disclose or suggest the above cited elements of claims 1 and 23.

Bauer discloses a database synchronizer to facilitate synchronization between client-side and server-side applications containing similar data structures. See *Bauer* at Abstract. The Examiner cites to col. 1, lines 50-57 and col. 2, lines 1-5 of *Bauer* as teaching a server requesting a data object definition message from a client, and the client transmitting the data object definition message upon request to the server. See Office Action at 8. However, nowhere in these citations is there a teaching or suggestion of a data format, let alone transmitting a change in that data format. Therefore, *Bauer*, like *Lonnroth* and *Dutta*, fails to disclose or suggest "transmitting a change of the data format from the client to the server in a data object definition message," and "automatically adapting the translation code to the changed data format upon receipt of the data object definition message," as recited in claim 1 or in the similar language included in claim 23.

Therefore, for at least the reasons stated above with respect to claims 1 and 23, a *prima facie* case of obviousness for claims 11-13, 15-22, 33-35, and 37-44, which depend directly or indirectly from claims 1 and 23 and therefore include all the limitations thereof, has not been established. In addition, no additional evidence has been raised establishing a tenable rationale why one of ordinary skill would have been motivated to modify the references so as to arrive at the claimed invention. Except for claim 11, no statement or adequate rationale as to why the references are combinable is provided.

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With respect to the rejection of claim 11, the Office Action asserts, "It would have been obvious to a person of ordinary skill in the art... in order to ensure that the files of the server are up-to-date with the files of the client." See Office Action at 8.

At best, the Office Action's assertion could be considered an assertion that the proposed modifications could be performed. However, "[t]he mere fact that a reference <u>can</u> be combined or modified does not render the resultant combination [or modification] obvious unless the results would have been predictable to one of ordinary skill in the art." M.P.E.P. §2143.01 (emphasis in original). Combining *Lonnroth*, *Dutta* and *Bauer* would not result in a predictable variation of Applicant's invention because a hypothetical *Lonnroth*, *Dutta* and *Bauer* combination, which would lack recited elements, would not result in the elements recited in claims 1 and 23 of the present application. Because it would lack a recited element of Applicant's invention, it would not be a predictable variation of Applicant's invention.

For at least these reasons, Applicant submits that the Office has not met the burdens necessary to establish that claims 11-13, 15-22, 33-35, and 37-44 are obvious under §103(a). Therefore the §103(a) rejection of amended claims 11-13, 15-22, 33-35, and 37-44 is improper, and should be withdrawn.

iii. Claims 14 and 36

Claims 14 and 36 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Lonnroth* and *Dutta* as applied to claims 1, 11, 12, 23, and 33, in view of *Koskimies*. See Office Action at 10. Applicant respectfully traverses the rejection.

Claims 14 and 36 depend from independent claims 1 and 23, respectively, and include all the limitations thereof. As set forth above with respect to claims 1 and 23, the combination of *Lonnroth* and *Dutta* fails to teach, disclose or suggest the features recited in claims 1 and 23, and required by claims 14 and 36, namely, that "transmitting a change of the data format from the client to the server in a data object definition message," and "automatically adapting the translation code to the changed data format upon receipt of the data object definition message." *Koskimies* fails to cure the deficiencies of *Lonnroth* and *Dutta* discussed above. That is, *Koskimies* also fails to teach, disclose or suggest the above cited elements.

Koskimies discloses a method and equipment to allow a more sophisticated adaptive selection of data for synchronization or for software configuration. See *Koskimies* at para. [0007]. The Examiner cites to para. [0050] of *Koskimies* as teaching, "detect[ing] [data format changes] during an exchange of data between the server and the client." See Office Action at 10. In para. [0050], *Koskimies* discloses that its system analyzes the changes made to the selection data set and harmonizes the data items. However, nowhere in this paragraph or elsewhere in *Koskimies*, is there a suggestion of transmitting a data format change or adapting a translation code to the changed data format. Therefore, *Koskimies*, like *Lonnroth* and *Dutta*, fails to disclose or suggest "transmitting a change of the data format from the client to the server in a data object definition message," and "automatically adapting the translation code to the changed data format upon receipt of the data object definition message," as recited in claim 1 or in the similar language included in claim 23.

Therefore, for at least the reasons stated above with respect to claims 1 and 23, a *prima facie* case of obviousness for claims 14 and 36, which depend directly or indirectly from claims 1 and 23 and therefore include all the limitations thereof, has not been established. In addition, no additional evidence has been raised establishing a tenable rationale why one of ordinary skill would have been motivated to modify the references so as to arrive at the claimed invention.

The Office Action asserts, "It would have been obvious to a person of ordinary skill in the art... in order to be able to synchronize the client and the server in an efficient manner by knowing beforehand that a synchronization between the client and server is needed." See Office Action at 10.

At best, the Office Action's assertion could be considered an assertion that the proposed modifications could be performed. However, "[t]he mere fact that a reference <u>can</u> be combined or modified does not render the resultant combination [or modification] obvious unless the results would have been predictable to one of ordinary skill in the art." M.P.E.P. §2143.01 (emphasis in original). Combining *Lonnroth*, *Dutta* and *Koskimies* would not result in a predictable variation of Applicant's invention because a hypothetical *Lonnroth*, *Dutta* and *Koskimies* combination, which would lack recited elements, would not result in the elements recited in claims 1 and 23 of the present application. Because it would lack a recited element of Applicant's invention, it would not be a predictable variation of Applicant's invention.

For at least this reason, Applicant submits that the Office has not met the burdens necessary to establish that claims 14 and 36 are obvious under §103(a).

Therefore the §103(a) rejection of amended claims 14 and 36 is improper, and should be withdrawn.

III.   <u>Conclusion</u>

In view of the foregoing remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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